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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,765	03/20/2001	Richard J. Ternien	RICK-04937	8883

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EXAMINER
POPOVICS, ROBERT J

ART UNIT	PAPER NUMBER
1724	

DATE MAILED: 10/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/812,765	Applicant(s)	Terrien et al.
Examiner	Popovics	Group Art Unit	1724

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

Responsive to communication(s) filed on 10/15/01 (IDS)

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-16 is/are pending in the application.

Of the above claim(s) 8-16 is/are withdrawn from consideration.

Claim(s) 1-7 is/are allowed.

Claim(s)  is/are rejected.

Claim(s)  is/are objected to.

Claim(s)  are subject to restriction or election requirement

### Application Papers

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a METHOD FOR REMOVING AN OIL CONTAMINANT FROM THE SURFACE OF AN AQUEOUS SOLUTION, classified in class 210, subclass 776.
  - II. Claims 8-16 (two claims numbered "11"), drawn to a DEVICE/SYSTEM FOR REMOVING AN OIL CONTAMINANT FROM THE SURFACE OF AN AQUEOUS SOLUTION, classified in class 210, subclass 241.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as in the removing of debris from a swimming pool surface.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. Jaen Andrews on September 30, 2002 a provisional election was made **without** traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-16 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

7. It is requested that Applicants **cancel the non-elected claims** with their next response to this Office Action.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gore (US 5,948,266).

See col. 1, lines 54-57 where industrial application is discussed.

***Claim Rejections - 35 USC § 103***

10. Claims 3-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore (US 5,948,266).

Claims 3 and 6 specify the solution to be enclosed in a tank. While the preferred use of the Gore skimmer is to remove gas or oil sheens from the surface waters in a marina, Gore expressly teaches that his skimmer may be used in "certain industrial situations and liquid purification operations" (col. 1, lines 54-57). In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the skimmer of Gore in industrial applications involving solutions stored in tanks. It is submitted that such applications would be readily apparent to the skilled artisan. With respect to claim 7, it is submitted that use of the skimmer of Gore would have been obvious in various "manufacturing" processes, in order to remove tramp oil from machine tool coolant for example.

***Claim Rejections - 35 USC § 112***

11. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 4, it is unclear what Applicants intend by the recitations "*way oils*" and "*hobbing oils*."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Popovics whose telephone number is (703) 308-0684.

RJP  
September 30, 2002



ROBERT POPOVICS  
PRIMARY EXAMINER